

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS**

In re

Decision on
Petition for Regrade
Under 37 C.F.R. § 10.7(c)

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MEMORANDUM AND ORDER

(Petitioner) petitions for regrading his answers to questions 20, 27, 31, and 45 of the morning session of the Registration Examination held on April 21, 1999. The petition is denied to the extent Petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On August 2, 1999, Petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Commissioner.

OPINION

Under 37 C.F.R. § 10.7(c), Petitioner must establish any errors that occurred in the grading of the examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning section state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of Petitioner's arguments have been considered. Each question in the examination is worth one point.

Petitioner has been awarded points for morning questions 20, 27, and 45 because these questions have been eliminated from the examination. Accordingly, petitioner has been granted an additional three points on the examination, resulting in a regraded score of 69. However, no error in grading has been shown as to morning question 31, therefore no credit has been awarded for the question.

Morning question 31 reads as follows:

Answer Questions 30 and 31 independently of each other and based upon the following information. You have drafted and filed a patent application for JoJo Industries directed to a device for mechanically flushing food storage containers with gases which includes the following disclosure and drawings:

The gas flushing device of the present invention, illustrated generally at **10** in FIG. **1**, includes a main body **11** having a piston portion **12** with holes **14** that is securely attached to a piston rod **16**. The piston rod **16** is in communication with a source of a flushing gas such as carbon dioxide. The piston rod **16** conveys flushing gas to a chamber **17** in which the flushing gas under pressure exits through holes **14**.

In one preferred embodiment, the piston portion **12** of the gas flushing device **10** includes a bottom surface **18** that is substantially circular. The bottom surface **18** of the piston portion **12** is preferably made of a non-stick material such as nylon or teflon. The piston portion **12** also includes a cylindrical side surface **20** that meets the bottom surface **18** at the circumference of the bottom surface **18**. For a flat bottom surface **18**, the cylindrical surface **20** is substantially perpendicular to the bottom surface **18**.

The piston portion **12** also includes at least one hole **14**. In one embodiment, the hole **14** is positioned in the bottom surface **18** of the piston portion **12**. In another embodiment, the piston portion **12** includes a plurality of holes that are located on the bottom surface **18**. In another embodiment, the piston portion **12** includes a plurality of holes that are located on each of the bottom surface **18** and the cylindrical surface **20** (emphasis added). The piston portion **12** is securely attached to the hollow rod portion **16** by a threaded section **25** on the piston rod portion **16** that engages a threaded section **27** on the piston portion **12**. The piston rod portion **16** may be detached from the piston portion **12** by disengaging the threaded sections, thereby facilitating cleaning of the flushing device **10**.

The piston rod portion **16** of the main body **11** shown in FIG. **1** is hollow rod. The piston rod portion **16** is threadably attachable to and detachable to a source of flushing gas. In one embodiment, the piston rod portion **16** and piston portion **12** are parts of a single substantially hollow main body **11**.

The following independent claim is included in the application:

1. A gas flushing device for flushing a container enclosing food comprising a main body (11) that includes a piston portion (12) with a least one hole (14) providing direct contact between the gas and the food, a piston rod portion (16) which is threadably attachable to and detachable to a source of flushing gas and which is securely attached to the piston portion (12), the piston portion (12) having a nonstick surface (18).

31. Which of the following dependent claims, if any, cover the embodiment described in lines 15-16 of the disclosure?

- (A) 2. A gas flushing device as set forth in Claim 1 wherein the piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.
- (B) 3. A gas flushing device of Claim 2 wherein the piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.
- (C) 2. The gas flushing device of Claim 1 wherein the piston portion includes a cylindrical surface perpendicular to a bottom surface and said piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.
- (D) (A), (B), and (C).
- (E) (A) and (C).

Choice (C) is the most correct answer. Choices (A), (B), and (C) all provide dependent claims covering the embodiment described in lines 15-16 of the disclosure. Specifically, “piston portion includes a plurality of holes located on each of said bottom surface and said cylindrical surface.” Choice (C) is the most correct answer because choice (C) is the only answer that provides a dependent claim with proper antecedent basis for “said bottom surface” and “said cylindrical surface.” Choice (A) is not correct because “said bottom surface” and “said cylindrical surface” lack antecedent basis. Accordingly, choices (D) and (E) are also not correct. Choice (B) is not correct because the dependent claim in choice (B) requires a claim 2, which is not given in the fact pattern in the question. Furthermore, “said bottom surface” and “said cylindrical surface” lack antecedent basis.

Petitioner contends choice (B) is the correct answer. Petitioner infers “[f]rom claim 1 it is conceivable that claim 2 will include language discussing a cylindrical surface and bottom surface embodiments thus providing antecedent for claim 3.” Petitioner argues that choice B is a proper dependent claim and claim 3 in choice B is “succinct and provides a further embodiment as

disclosed in lines 15–16.” Petitioner further maintains “this is done so with the idea that claim 2 has already mentioned ‘a cylindrical surface and a bottom surface.’”

Petitioner’s arguments are not persuasive because the arguments are based on facts not given, specifically there is a claim 2 that “will include language discussing a cylindrical surface and bottom surface embodiments thus providing antecedent for claim 3.” The directions to the question state “[a]nswer Questions 30 and 31 independently of each other.” The Examination Directions provide “[d]o not assume any additional facts not presented in the questions.” Petitioner’s assumption of facts not presented in the question violates to the Examination Directions. Choice (B) provides a claim 3 that depends on a claim 2, which is not given in the fact pattern, and there is insufficient antecedent basis for “said bottom surface” and “said cylindrical surface. Thus, choice (B) is not correct.

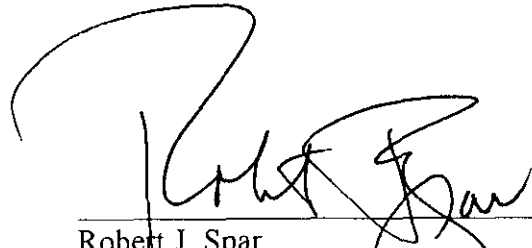
No error in grading has been shown as to question 31 of the morning session. Petitioner’s request for credit on this question is denied.

ORDER

For the reasons given above, three points have been added to Petitioner's score on the Examination. Therefore, Petitioner's score is adjusted to 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Commissioner, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects